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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,969	01/31/2005	Nerina Dodic	PF4909	8476
20462 7590 08/27/2007 SMITHKLINE BEECHAM CORPORATION CORPORATE INTELLECTUAL PROPERTY-US, UW2220 P. O. BOX 1539 KING OF PRUSSIA, PA 19406-0939			EXAMINER LOEWE, SUN JAE Y	
			ART UNIT 1626	PAPER NUMBER
			MAIL DATE 08/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/522,969	Applicant(s) DODIC ET AL.	
	Examiner Sun Jae Y. Loewe	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-11, 16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a national stage application of PCT/EP03/08496. Claims 1-11 and 16 are pending in the instant application. Claims 12-15 were cancelled by preliminary amendment filed on January 31, 2005.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-11 (in part) drawn to products of Formula I wherein ring A is imidazolyl and X=N, classified in various subclasses of class 544. Further election of a single compound is required.
- II. Claims 1, 3-8 and 11 (in part) drawn to products of Formula I wherein ring A is pyrazolyl and X=N, classified in various subclasses of class 544. Further election of a single compound is required.
- III. Claims 1, 3-8 and 11 (in part) drawn to products of Formula I wherein ring A is triazolyl and X=N, classified in various subclasses of class 544. Further election of a single compound is required.
- IV. Claims 1, 3-8 and 11 (in part) drawn to products of Formula I wherein ring A is imidazopyridinyl and X=N, classified in various subclasses of class 544. Further election of a single compound is required.

- V. Claims 1, 3-8 and 11 (in part) drawn to products of Formula I wherein ring A is thiazolyl and X=N, classified in various subclasses of class 544. Further election of a single compound is required.
- VI. Claims 1, 3-8 and 11 (in part) drawn to products of Formula I not covered by Groups I-VI. Further election of a single compound is required. Further restriction may apply.
- VII. Claim 16 drawn to process of using products of Group I. Further election of a single species is required.
- VIII. Claim 16 drawn to process of using products of Group II. Further election of a single species is required.
- IX. Claim 16 drawn to process of using products of Group III. Further election of a single species is required.
- X. Claim 16 drawn to process of using products of Group IV. Further election of a single species is required.
- XI. Claim 16 drawn to process of using products of Group V. Further election of a single species is required.
- XII. Claim 16 drawn to process of using products of Group VI. Further election of a single species is required. Further restriction may apply.

3. The inventions listed as Groups I-XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons.

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The technical feature linking the subject matter of Groups I-XII is a core structure which is taught in the prior art (eg. Ochiai et al.).

L4 ANSWER 60 OF 60 CAPLUS COPYRIGHT 2007 ACS on STN

AN 1950:7591 CAPLUS Full-text

DN 44:7591

OREF 44:1502c-d

TI Polarization of aromatic heterocyclic compounds. LXXVI. Reaction of Grignard reagent with pyridine-N-oxide

AU Ochiai, Eiji; Arima, Koh

SO Yakugaku Zasshi (1949), 69, 51-4

CODEN: YKKZAJ; ISSN: 0031-6903

DT Journal

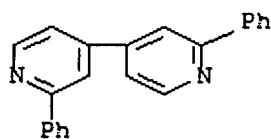
LA Unavailable

AB cf. C.A. 35, 743.6. PhMgBr was added to pyridine 1-oxide in anhyd. C₆H₆ (the reaction is exothermic), and the basic product dissolved in C₆H₆, and purified chromatographically with Al₂O₃; the filtrate contained a white waxy substance (I) and the adsorbed layer gave an oily base (II), b₁₀ 170.degree.. II was identified as 2-phenylpyridine through its picrate, m. 175-6.degree.. I, white leafy crystals from C₆H₆-petr. ether, m. 190.degree.; picrate, m. 183-4.degree.; HCl salt, m. 128.degree.. Analysis showed I is diphenylbipyridine (III). The ratio of yield of II and III was 3:5.

IT 219695-26-8, 4,4'-Bipyridine, 2,2'-diphenyl- (and salts)

RN 219695-26-8 CAPLUS

CN 4,4'-Bipyridine, 2,2'-diphenyl- (9CI) (CA INDEX NAME)



4. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows: compounds encompassed by the generic definition of Formula I, obtained by varying the substituents R^1 - R^3 , variable X and ring A. For example, compounds listed in claim 10.

Applicant is required, in reply to this action, to elect a single species within the elected group to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. The claims are deemed to correspond to the species listed above in the following manner: claims 1-9, 11 and 16 are generic.

6. The species described within section 4 do not relate to a single general inventive concepts under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reason:

The Markush group defined by Formula I does not fulfill criteria (B)(1) or (B)(2) in MPEP § 1850.III.B., a requirement of PCT Rule 13.2. The only common core shared by all compounds instantly claimed is a pyridine linked to phenyl structure. This structure neither

occupies a substantial part of the structure of the compounds claimed nor make a contribution over the prior art (above).

7. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species and invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention and species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sun Jae Y. Loewe whose telephone number is (571) 272-9074.

The examiner can normally be reached on M-F 7:30-5:00 Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sun Jae Y. Loewe, Ph.D.
Art Unit 1626



REBECCA ANDERSON
PRIMARY EXAMINER